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/karen buzinski/
Karen Buzinski

Customer Number

24024

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Chen <i>et al.</i>)	Examiner:	Taylor Oh
)		
Serial No.:	10/597,022)	Art Unit:	1625
)		
Filed:	June 18, 2007)	Confirmation No.:	4927
)		
For:	ZN²⁺-CHELATING MOTIF- TETHERED SHORT-CHAIN FATTY ACIDS AS A NOVEL CLASS OF HISTONE DEACETYLASE INHIBITORS)	Attorney Docket No.:	22727/04418

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. §§ 1.183 TO WAIVE REQUIREMENT FOR STATEMENT
OF LACK OF DECEPTIVE INTENT FROM INVENTOR TO BE DELETED**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a petition to waive the requirement under 37 CFR 1.48(a) for a statement from each person being added or deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part. A request to correct inventorship under 37 CFR 1.48(a) has been submitted concurrent with this petition, as well as a declaration by the actual inventor, Ching-shih Chen, pursuant to 37 C.F.R. §1.63.

In support of this petition, the representative of the applicant submits the following:

Subsequent to the filing of the present application, additional analysis of the information relating to the conception of the claimed invention indicated that the initial listing of Qiang Lu as an inventor was incorrect. For example, review of the grant proposal that served as the basis of the invention indicated that (1) all of the compounds of the invention and their pharmaceutical target were known before the work by Qiang Lu was carried out, and (2) Qiang Lu did not come up with the claimed compounds. Further discussion with inventor Ching-shih Chen also revealed that the preparation of these compounds was routine and well within the ordinary skill of one skilled in the art of organic chemistry.

Upon discovery that inventorship of the application required correction, an e-mail was sent to the e-mail address provided by Assignee for Qiang Lu in which I provided a copy of the statement of lack of deceptive intent. A copy of this statement is provided as Exhibit A. No response to this email was received. After determining that Qiang Lu could be reached at Cognigen Corporation, I initiated a telephone conversation with Qiang Lu in which I described why we needed to change inventorship, and that I would be resending a copy of the statement of lack of deceptive intent to him. Qiang Lu would not agree to signing the document at this point, and I received no response after I resent the document to him.

On July 13, 2011, another e-mail was sent to Qiang Lu repeating the request that he sign the copy of lack of deceptive intent. There was no response to the e-mail. I then left a message for Qiang Lu at Cognigen Corp., asking him to sign and return the document. Qiang Lu responded by e-mail on August 7, 2011 that he carried out the synthesis, and was therefore an inventor, and that removing his name would invalidate the patent. See Qiang Lu's e-mail as Exhibit B. I then asked Qiang Lu if he would be interested in meeting with me to discuss inventorship further, but received no response. We therefore at this time respectfully assert that Qiang Lu has refused to sign the statement of lack of deceptive intent, and petition that the requirement for this statement be waived.

Pursuant to 37 C.F.R. § 1.183, and following the guidelines set forth in 37 C.F.R. § 1.48,

the fee (\$400.00) required under 37 C.F.R. § 1.17(f) is included.

Respectfully submitted,

Date: November 22, 2011

By: /Raymond Russell/
Raymond N. Russell, Ph.D.
Reg. No. 52,185
(216) 622-8373 Telephone
(216) 241-0816 Facsimile
rrussell@calfee.com

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Ching-Shih Chen)	Group Art Unit: 1625
Application No.: 10/597,022)	Confirmation No.: 4927
Filed: June 18, 2007)	Examiner: Taylor V. Oh
For: Zn ²⁺ -Chelating Motif-Tethered Short-Chain)	Attorney Docket No.: 22727/04418
Fatty Acids as a Novel Class of Histone)	
Deacetylase)	

STATEMENT OF QIANG LU UNDER 37 C.F.R. § 1.48(a) TO CORRECT
INVENTORSHIP

Qiang Lu declares:

1. That he is listed as an inventor for U.S. Patent Application No. 11/423,194, which was filed on June 9, 2006;
2. That he was incorrectly listed as an inventor at the time of filing of the application and at the time of submission of the original Declaration;
3. That the error resulting in his being listed as inventor at the time of filing of the application and at the submission of the original Declaration arose without any deceptive intent on his part;
4. That as soon as the error was known, the necessary steps were taken to correct the error in inventorship; and
5. That all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like are punishable by fine or

imprisonment, or both, under 18 U.S.C. § 1001, and that such statements may jeopardize the validity of the application or of any patent resulting therefrom.

Date: _____

Qiang Lu

Russell, Raymond N.

From: Russell, Raymond N.
Sent: Thursday, August 11, 2011 5:08 PM
To: 'qiang lu'
Subject: Analysis of inventorship for the Zinc Chelating Motif Tethered Short Chain Fatty Acids as a Novel Class of Histone Deacetylase Inhibitors patent application

Dear Dr. Lu,

Thank you for responding to my earlier e-mail. Since you feel strongly that you should be listed as an inventor for this application, we are going to carry out a more formal study of inventorship for this application to make sure we have all of the facts before we proceed. If it really does appear that you should remain listed as an inventor, we will not change the inventorship for this application.

To carry out my analysis, I would like to meet with you and Dr. Chen, at separate times, to discuss the work that was carried out. It is not too difficult to reach Dr. Chen, as he is Columbus, but it is more challenging to reach you in Buffalo, NY. Do you ever visit the Cleveland area? Alternately, we could meet halfway at Erie, Pennsylvania, or do our best to sort through your work over the phone. Please let me know what you would prefer. In addition, please consider what supporting documents you might have available to demonstrate your role in the development of this invention.

I look forward to speaking with you.

From: qiang lu [mailto:luqiang_osu@hotmail.com]
Sent: Sunday, August 07, 2011 11:05 PM
To: Russell, Raymond N.
Subject: RE: Change of inventorship for the Zinc Chelating Motif Tethered Short Chain Fatty Acids as a Novel Class of Histone Deacetylase

Raymond Russell,

I did not just carried the experiment. I came up with the compounds and the synthetic process. I believe I am qualified as an inventor. Removing my name from the inventorship will invalidate the patent.

Qiang Lu

From: RRussell@Calfee.com
To: luqiang_osu@hotmail.com
CC: bender.151@osu.edu; chen@pharmacy.ohio-state.edu
Date: Wed, 13 Jul 2011 11:30:43 -0400
Subject: Change of inventorship for the Zinc Chelating Motif Tethered Short Chain Fatty Acids as a Novel Class of Histone Deacetylase

Re: U.S. Utility Patent Application No. 10/597,022
For: ZN2+-CHELATING MOTIF-TETHERED
SHORT-CHAIN FATTY ACIDS AS A NOVEL
CLASS OF HISTONE DEACETYLASE INHIBITORS
Inventors: Chen *et al.*
Filed: June 18, 2007
OSU Ref. No.: 04ID14F; CHG Ref. No.: 22727/04418

Qiang Lu,

As you may recall, I contacted you by phone and sent a follow-up letter regarding change of inventorship for the above-identified application earlier this year. A copy of my earlier e-mail can be found below. I never received a response to my earlier e-mail, and am unclear if this happened because you never received my earlier e-mail, or because you have decided not to cooperate in the change of inventorship.

I am resending the document regarding change of inventorship. Please let me know if you have received this document, and if you are willing to sign it and send us a copy so that we can change inventorship for this application. If you have any questions regarding the meaning of this form or why we are changing inventorship, I would be happy to answer them for you. You can send the signed document through e-mail as a scanned document, or you can send it by mail to the following address:

Raymond Russell, Ph.D.
Calfee, Halter & Griswold, LLP
1400 KeyBank Center
800 Superior Avenue
Cleveland, Ohio 44114-2688

If I do not hear from you by the end of the week, I will attempt to reach you at your office. If I cannot reach you at your office, we will be forced to assume that you are either unavailable or unwilling to cooperate in the change of inventorship, at which point we can proceed to change inventorship through a different procedure.

Best Regards,

Raymond N. Russell
Attorney At Law
rrussell@calfee.com
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From: Russell, Raymond N.
Sent: Tuesday, February 01, 2011 5:27 PM
To: 'luqiang_osu@hotmail.com'
Cc: 'New, Jane'; 'Ching-Shih Chen'
Subject: Change of inventorship for the Zinc Chelating Motif Tethered Short Chain Fatty Acids as a Novel Class of Histone Deacetylase

Re: U.S. Utility Patent Application No. 10/597,022

**For: ZN2+-CHELATING MOTIF-TETHERED
SHORT-CHAIN FATTY ACIDS AS A NOVEL
CLASS OF HISTONE DEACETYLASE INHIBITORS**

Inventors: Chen *et al.*

Filed: June 18, 2007

Your Ref. No.: 04ID14F; CHG Ref. No.: 22727/04418

Qiang Lu,

Thank you for taking the time to discuss a change of inventorship for the above-identified patent application. I have attached a copy of the application to refresh your memory regarding its contents. As you recall, this is the US version of the international PCT application that was originally filed.

As I discussed on the phone, OSU has asked me to work on changing the listed inventorship of this application based on a reevaluation of the inventorship of this patent carried out in 2008. Unfortunately, it appears that the original listing of inventors was not made based using the proper legal standard for inventorship. While you were listed as one of the original inventors for this application, this re-evaluation indicated that you were simply carrying out combinatorial synthesis of the HDAC inhibitors based on instructions from Dr. Chen, which typically is not sufficient for one to be considered an inventor. If you believe you developed compounds or synthetic techniques for the preparation of these compounds that would not have been obvious to a chemical practitioner in this area, please let us know, as this could affect the determination of inventorship.

Please let me know if you are comfortable being removed as an inventor for this application, or if you have any additional questions. If you agree that you should not be listed as an inventor, please sign the attached statement and return a signed copy to us at your earliest convenience.

Best Regards,